

REMARKS:

Applicant has carefully studied the nonfinal Examiner's Action and all references cited therein. The amendment appearing above and these explanatory remarks are believed to be fully responsive to the Action. Accordingly, this important patent application is now believed to be in condition for allowance.

Applicant responds to the outstanding Action by centered headings that correspond to the centered headings employed by the Office, to ensure full response on the merits to each finding of the Office.

Election/Restrictions

In response to the restriction requirement, Applicant elects to pursue claims 1-28, drawn to a device and method of electromanipulation classified in class 604, subclass 20. Accordingly, claims 29-33 have been withdrawn.

Drawings

The drawings have been objected to because the lines and shading are not uniform, clean and well defined. Replacement drawings for Fig. 1-Fig. 4 are presented in response to this Office Action to overcome the objection by the Office.

Claim Objections

Claim 27 and 28 stand objected to due to informalities.

Appropriate correction to the claims has been presented in this response to overcome the objection by the Office.

Claim Rejections – 35 U.S.C. § 112

Applicant acknowledges the quotation of 35 U.S.C § 112, first paragraph.

Claims 12-16 stand rejected under 35 U.S.C § 112, first paragraph as failing to comply with enablement requirement. The Office states that claim 12 is drawn to adapting this device for implantation into a patient, but the description of how to adapt the device for implantation is not described in the specification.

Claim 12 and 13 have been canceled and claims 14-16 have been amended to overcome the rejection by the Office.

Claim Rejections – 35 U.S.C. § 102

Applicant acknowledges the quotation of 35 U.S.C § 102(b).

Claims 1-8, 10 and 19-28 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,318,514 to Hofmann.

With respect to claim 1, the Office states that Hofmann discloses a device for electromanipulation of chemical species in vivo relative to a target tissue (abstract) comprising: an array base (22) adapted to be placed coincident to the target tissue (column 2, lines 61-63); a plurality of electrode elements (18) secured in spaced apart relation on the array base (figures 2 and 3), the electrode elements adapted to be coupled to an electrical source (column 2, lines 49-50).

Independent claims 1 and 23 have been amended to more clearly describe that which Applicant regards as the invention. Amended claims 1 and 23 describe a device for electromanipulation of chemical species in vivo relative to a target tissue which includes a substantially planar nonconductive sheet conformable to the topography of the surface of the target tissue, a plurality of electrode elements secured in spaced apart relation on the sheet, wherein the electrode elements are adapted to be coupled to an electrical source.

Applicant contends that Hofmann does not anticipate amended claims 1 and 23 because Hoffman does not teach a device for electromanipulation of chemical species in vivo relative to a target tissue which includes a substantially planar nonconductive sheet conformable to the topography of the surface of the target tissue which includes a plurality of electrode elements.

For the reasons indicated above, amended claims 1 and 23 of the present invention are not anticipated by Hofmann and are believed to be in condition for allowance.

Claims 3-11 and 14-22 are dependent upon claim 1, which has been shown to be allowable, and are therefore allowable as a matter of law.

Claims 2, 12, 13 have been cancelled.

Claim 24 has been amended to more clearly describe that which the Applicant regards as the invention. Amended claim 24 describes a method which includes placing at least one substantially planar nonconductive sheet conformable to the topography of the surface of the target tissue coincident to the target tissue, the at least one sheet containing a plurality of electrode elements, establishing an electrical potential between at least two electrode elements in the plurality of electrode elements, providing a chemical species coincident to the target tissue, and controlling the electrical potential whereby the chemical species are delivered to the target tissue.

Applicant contends that Hofmann does not anticipate claim 24 because Hofmann does not describe the step of amended claim 24 which includes placing at least one substantially planar nonconductive sheet conformable to the topography of the surface of the target tissue coincident to the target tissue.

For the reasons indicated above, amended claim 24 of the present invention is not anticipated by Hofmann and is believed to be in condition for allowance.

Claims 25-29 are dependent upon claim 24, which has been shown to be allowable, and are therefore allowable as a matter of law.

Claim Rejections – 35 U.S.C. § 103

Applicant acknowledges the quotation of 35 U.S.C § 103(a).

Claims 9 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,318,514 to Hofmann.

In a *prima facie* case of obviousness the prior art cited must teach or suggest all the claim limitations. As previously argued, the Hofmann reference does not teach Applicant's system including at least one substantially planar nonconductive sheet conformable to the topography of the surface of the target tissue. Applicant has already shown that Hofmann does not contain all the elements of the present invention. A *prima facie* case of obviousness has not been established for claims 9 and 11 because the cited reference fails to disclose all the elements of Applicant's invention. Applicant is therefore under no obligation to submit evidence of nonobviousness.

Claims 12-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hofmann (U.S. Patent No. 5,318,514) in view of U.S. Patent 5,501,662 to Hofmann.

Claims 12 and 13 have been cancelled by amendment and claims 14 and 15 have been amended to dependent from claim 10, which has been shown to be allowable. Applicant therefore believes that amended claims 14 and 15 are patentable over Hofmann '514 in view of Hofmann '662 and are believed to be in condition for allowance.

Claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hofmann (U.S. Patent No. 5,318,514) in view of U.S. Patent 5,501,662 to Hofmann in further view of U.S. Patent No. 5,284,135 to Hauck et al.

In a *prima facie* case of obviousness the prior art cited must teach or suggest all the claim limitations. As previously argued, the Hofmann reference does not teach Applicant's system including at least one substantially planar nonconductive sheet conformable to the topography of the surface of the target tissue. Applicant has already shown that Hofmann does not contain all the elements of the present invention. A *prima facie* case of obviousness has not been established for claim 16 because the cited references fail to disclose all the elements of Applicant's invention. Applicant is therefore under no obligation to submit evidence of nonobviousness.

Claims 17 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hofmann (U.S. Patent No. 5,318,514) in view of U.S. 2004/0039343 to Eppstein et al.

In a *prima facie* case of obviousness the prior art cited must teach or suggest all the claim limitations. As previously argued, the Hofmann reference does not teach Applicant's system including at least one substantially planar nonconductive sheet conformable to the topography of the surface of the target tissue. Applicant has already shown that Hofmann does not contain all the elements of the present invention. A *prima facie* case of obviousness has not been established for claims 17 and 18 because the cited references fail to disclose all the elements of Applicant's invention. Applicant is therefore under no obligation to submit evidence of nonobviousness.

If the Office is not fully persuaded as to the merits of Applicant's position, or if an Examiner's Amendment would place the pending claims in condition for allowance, a telephone call to the undersigned at (813) 925-8505 is requested.

Very respectfully,
SMITH & HOPEN



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Customer No. 21,901

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CERTIFICATE OF ELECTRONIC TRANSMISSION

(37 C.F.R. 2.190 (b))

I HEREBY CERTIFY that this Preliminary Amendment is being electronically transmitted to the Patent and Trademark Office through EFS Web on March 17, 2008.

Date: March 17, 2008

/lauren reeves/

Lauren Reeves